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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/914,537 | 12/13/2001 | Gerhard J Bleys | P 282804/EUR | 8094 |
| 37058 | 7590 | 11/29/2005 | EXAMINER | |
| TIM HEADLEY GARDERE WYNNE SEWELL LLP 1000 LOUISIANA, SUITE 3400 HOUSTON, TX 77002 | | | SERGENT, RABON A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1711 | |

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914,537

Applicant(s)

BLEYS ET AL.

Examiner

Rabon Sergeant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-12 and 16-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-12 and 16-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-4, 6-12, and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bleys ('226) or Bleys et al. ('779) or Eling et al. ('483), each in view of Oertel (Polyurethane Handbook: Chemistry - Raw Materials - Processing - Application - Properties).

Bleys and Bleys et al. and Eling et al. disclose the production of resilient flexible polyurethane foams prepared from the reaction of water, 4,4'-diphenylmethane diisocyanate, and polyether polyols, having greater than 50% by weight oxyethylene groups, functionalities of 2-6, and equivalent weights that overlap those claimed by applicants. See abstracts. Furthermore, patentees disclose that prepolymer processes may be employed and that the polyurethanes may be molded. See column 3, lines 53+ within Bleys. See abstract and column 5, line 13 within Bleys et al. See abstract and column 4, lines 61+ within Eling et al.

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3. Though the primary references are silent regarding applicants' claimed process of coating the mold with an external release agent and producing at least 10 moldings prior to recoating the mold with the external release agent, the position is taken that, in the production of polyurethane foams, the initial coating of a mold with an external release agent to facilitate removal of the foam from the mold was considered necessary and indispensable at the time of invention. This position is supported by the teachings of Oertel at pages 114 and 115. Oertel further discloses that use of the release agent extends the production cycle, which suggests that multiple moldings are produced per mold release application. Finally, Oertel discloses types of mold release agents that correspond to those disclosed by applicants, the characteristics that effect mold release, and that the best mold release agent may be found through experimental optimization; therefore, Oertel sets forth fundamental guidelines that would have enabled the skilled artisan to arrive at molding processes having optimum mold release characteristics. Therefore, it would have been obvious to produce moldings utilizing the disclosed foam composition of the primary references and to utilize external mold release agents, selected through optimization, so as to yield processes having the most desirable demolding characteristics, such as ease of release and number of releases between release agent application.

4. Applicants' disclosed examples have been considered; however, they are insufficient to establish any showings of unexpected results. The examples merely demonstrate the expected result that improved mold release is obtained when an external mold release agent is utilized as opposed to when an external mold release agent is not utilized. Furthermore, no examples have been set forth to demonstrate that the instant foam composition yields improved mold release as compared to the foam compositions of the primary references. In fact, given the similarity of the

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disclosed foam compositions and the instant composition, one would expect the disclosed foam compositions to display similar mold release properties to those of the instant composition, all else being equal. It has been held that the discovery of an inherent property (i.e.; beneficial mold release) of a known composition does not rise to the level of invention.

5. Applicants' 37 CFR 1.132 declaration of September 15, 2005 has been considered, and as a result, the obviousness rejection over Bleys ('226) or Bleys et al. ('779) or Eling et al. ('483), each in view of Mackey ('409 or '553 or '528) has been withdrawn.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.


RABON SERGENT
PRIMARY EXAMINER

R. Sergent
November 22, 2005